

REMARKS**I. Election Requirement**

Kit claims 7, 10, 14 and 15 have been canceled in response to the decision to make the restriction requirement final in paragraph 2 of the Office Action. However applicants may file a subsequent divisional application to prosecute kit claims.

II. Other Claim Changes

Independent method claim 5 has been amended to further distinguish the subject matter of claim 5 from the prior art. No other changes have been made in the previously presented claims, except for cancellation of the kit claims.

New method claim 5 has been amended to limit the physically compatible salts in the pre-treatment preparation or aqueous preparation to those which "promote absorption of an anionic, direct dye applied to the keratinic fibers". Basis for this change is found in the 4th full paragraph of page 2 of applicants' specification and in the original abstract. Salts, which are effective in promoting the absorption, are claimed in claim 11, as disclosed in the 1st and 2nd full paragraphs on page 8 of the specification. Also see the comparative dyeing results on pages 11 and 12 of the applicants' specification that show that the method improves the intensity of dyed hair colors.

New method claim 20 claims a method in which a ready-to-dye mixture of

at least one anionic direct dye and at least one salt capable of promoting absorption of the anionic direct dye is applied to the hair in a single step to dye hair. This new claim 20 claims a method within the scope of the canceled, but originally filed, method-of-use claim 1. See also examples 1.1 to 1.5 on pages 8 and 9 of the applicants' specification.

The distinguishing factor for the subject matter of both claims 5 and 20 is the limitation to only those salts, which can promote absorption of the anionic direct dye. Salts, which do that, are recited in the specification and claims 11 and 12. It is understandable that all salts would not promote such absorption at least to a degree sufficient enough to provide better dyed hair colors.

New independent method claims 16, 17 and 18 have also been filed. These claims are of varying scope. Their subject matter is distinguishable from the cited prior art reference, Dias.

New claim 16 claims an aqueous pre-treatment composition containing a physiologically compatible salt of an organic or inorganic acid, like unamended claim 5, but with the further limitation that this composition does not contain any oxidizing agent. Basis for this claim is the applicants' exemplary compositions on pages 8 and following of applicants' specification. Furthermore the cosmetic additive ingredients recited on page 6 to 7 of applicants' specification do not contain any oxidizing agent. There is no oxidizing agent in the exemplary compositions on pages 8 and following. Thus the specification supports the limitation that there is no oxidizing agent in the claimed composition and new claim 16.

New claim 17 claims a method using an aqueous preparation similar to unamended claim 5 in that it contains the physiologically compatible salt. However the aqueous preparation of claim 17 is further limited to "**consist of** water, the salt for promoting absorption of the anionic direct dye and at least one conventional additive ingredient". The conventional additive ingredients are limited to the ingredients recited on pages 6 and 7 of the specification. These latter ingredients do not include any oxidizing agents.

The "consisting of" wording of claim 17 excludes the oxidizing agents from the aqueous pre-treatment composition. Thus the basis for distinguishing from the prior art for claims 16 and 17 is similar.

Claim 18 is also new. It is similar to unamended claim 5, except that it limits the salt for promoting absorption of the anionic direct dye to salts that do that recited in dependent claims 11 and 12. Other salts are excluded by the wording of new claim 18. Basis for this claim is in the unamended claim 5 and claim 8.

New dependent method claims 19, 21 and 22 contain subject matter from the previously filed dependent method claims, such as claims 11 and 12.

III. Obviousness Rejection Based on Dias

Claims 5, 6 and 11 to 13 were rejected under 35 U.S.C. 103 (a) as obvious over Dias, U.S. Patent 6,540,791.

Dias does disclose a method of bleaching and coloring hair. In some embodiments of the method (column 49) a first component is applied to hair

followed by a second component, which includes the hair-coloring agent (dye compound). The first component necessarily contains an oxidizing agent and a buffer for pH 5 to 11 including borates and an alkalizing agent (claims 1, 2 and 20 of Dias).

First, applicants' respectfully point out that sodium chloride and many salts are not alkalizing agents because they do not change the pH. This is true of all alkali metal chloride and nitrate salts, for example. In other words, some, in fact, many salts are not alkalizing agents.

1. Independent Claims 5 and 20

Dias does not **disclose or suggest** including a salt in the compositions that promotes the absorption of an anionic direct dye. This underlined functional wording distinguishes the claimed method from other salts of the prior art that are not effective. Functional wording at the point of novelty is acceptable under 35 U.S.C. 112. See M.P.E.P. 2173.05. Furthermore the foregoing wording is both definite and fully supported by the current specification.

Compositions containing salts are of course very well known in the chemical arts. Applicants' new method claim 20 and amended method claim 5 claim a new use for well-known salt compositions, for example a water solution of sodium chloride. This use is of course promoting absorption of an anionic direct dye. The aqueous salt-containing preparations used in the inventive method are not necessarily buffer compositions as disclosed in Dias in column 46, lines 44 to 67. They are generally not alkalizing or basic compositions because they are most often neutral and do not change the pH.

It is old law that the way to claim a new use is by way of method claim language. For example, see *In re Moreton*, 129 USPQ 227 (CCPA 1961). This is exactly the situation here in relation to Dias. Dias does not teach improving absorption of an anionic direct dye by treating the fibers prior to or at the same time as applying the dye with a physiologically compatible anionic direct dye. There are no comparative dyeing experiments with and without an aqueous pretreatment composition disclosed in Dias as in applicants' specification.

Novelty and unobviousness are criteria for allowance of such new method-of-use claims, just like any other claims. The Dias reference neither discloses nor suggests the applicants' new-found use for aqueous salt compositions of amended claim 5 and new claim 20. Dias does not disclose or suggest the method of dyeing including the step of improving direct dye absorption using a salt solution, i.e. by pre-treating with it.

It is well established by many U. S. Court decisions that to reject a claimed invention under 35 U.S.C. 103 there must be some hint or suggestion in the prior art of the modifications of the disclosure in a prior art reference or references used to reject the claimed invention, which are necessary to arrive at the claimed invention. For example, the Court of Appeals for the Federal Circuit has said:

"Rather, to establish obviousness based on a combination of elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant...Even when obviousness is based on as single reference there must be a showing of a suggestion of motivation to modify the teachings of that reference.." *In re Kotzab*, 55 U.S.P.Q. 2nd 1313 (Fed. Cir. 2000). See also M.P.E.P. 2141.

There is no hint or suggestion of the feature that the aqueous pretreatment compositions used in the dyeing process should contain a physiologically compatible salt that improves absorption of the anionic direct dye.

Furthermore the Dias reference does not enable one skilled in the art to practice the inventive method of the applicants as claimed in claim 5 and 20 because it fails to identify those salts that will improve absorption of an anionic direct dye and the intensity of the colors produced by dyeing. The reference does disclose many pH modifiers and alkalizing agents that could be included, but it does not disclose or suggest, which of these compounds, some of which are salts, would help produce more intense dyed colors or improved absorption of the direct dyes.

In addition the prior art reference, Dias, does not teach or suggest that any of the particular salts disclosed as optional pH modifiers, such as the citrates or tartarates, would improve absorption of the direct dyes. Some of the pH modifiers disclosed by Dias are listed in applicants' claim 11 or 18, but Dias does not disclose or suggest, which of the pH modifiers would be useful in improving absorption of a direct dye during dyeing. Obviously not all salts will be effective in improving absorption. Thus amended claims 5 and 20 have been limited to those salts that do improve absorption of the anionic direct dye with functional wording.

For the foregoing reasons it is respectfully submitted that amended claim 5 and new claim 20 and the claims dependent on them are not obvious from the disclosures in Dias.

2. New Method Claims 16 and 17

Both these claims use wording that excludes the presence of an oxidizing agent from the aqueous pre-treatment preparation containing the physiologically compatible salt(s) of unamended claim 5.

Since an oxidizing agent is a required ingredient of the bleaching compositions of Dias, according to claims 1, 2 and 20 of that reference, Dias teaches the opposite of the claimed invention according to applicants' claims 16 and 17. A reference that teaches the opposite from a claimed invention cannot be used to reject a claimed invention under 35 U.S.C. 103 (a). See M.P.E.P. 2145 X. Also the Federal Circuit Court of Appeals has said:

"In determining whether such a suggestion [of obviousness] can fairly be gleaned from the prior art, ..It is indeed pertinent that these references teach against the present invention. Evidence that supports, rather than negates, patentability must be fairly considered." *In re Dow Chemical Co.*, 837 F.2d 469,473, 5 U.S.P.Q.2d 1529, 1532 (Fed.Cir. 1988)

Thus claims 16 and 17 should not be rejected as obvious under 35 U.S.C. 103 (a) based on Dias because Dias teaches the opposite.

3. New Method Claim 18

New method claim 18 includes the features and limitations of unamended claim 5, and also claim 11, so that it is limited to a method using an aqueous preparation including the preferred salts recited in applicants' specification, which are known to improve absorption of the anionic directed dye.

Dias does disclose pH modifiers and some of the examples of the pH modifiers, such as sodium citrate and sodium tartarate, are recited in new claim

18 as salts that improve absorption of the anionic direct dye. However Dias states the pH modifiers are only optional ingredients, which are not even necessary to set the pH, which is set by required buffer ingredients including borates and alkalizing agents. These latter ingredients do not include any of applicants' salts. Also none of the exemplary compositions 1 to 18 of Dias include any of applicants' preferred salts, although they do include copper sulfate and sodium stannate (which are not salts of claim 18).

One skilled in the art would only arrive at one of applicants' compositions as claimed in claim 18 using hindsight and the applicants' disclosure in the specification as a guide to pick and choose among the thousands of optional ingredients disclosed in Dias. This type of hindsight procedure is impermissible under 35 U.S.C. 103 (a). For example, the Federal Circuit Court of Appeals has said:

"As in all determinations under 35 U.S.C. 103, the decision-maker must bring judgment to bear. It is impermissible, however, simply to engage in a hindsight reconstruction of the claimed invention, using the applicant's structure as a template and selected elements from references to fill the gaps". *In re Gorman*, 18 U.S.P.Q.2d 1885 (Fed. Cir. 1991).

There is no reasonable suggestion in Dias or the art that including the optional tartarate or citrate pH modifier will result in improved more intense dyed colors or dye absorption. There is no hint or suggestion that tartarate or citrate should be selected from the vast list of possible salts and pH modifiers for inclusive use an ingredient of the compounds of Dias for any reason.

Thus it is respectfully submitted that Dias does not establish a case of

prima facie obviousness of new claim 18 or the claims that depend on it.

For the foregoing reasons and because of the changes in claim 5, withdrawal of the rejection of claims 5, 6 and 11 to 13 under 35 U.S.C. 103 (a) over Dias is respectfully requested.

Also it is respectfully submitted that none of the new claims 16 to 22 should be rejected under 35 U.S.C. 103 (a) as obvious over Dias, U.S. Patent 6,540,791.

Should the Examiner require or consider it advisable that the specification, claims and/or drawing be further amended or corrected in formal respects to put this case in condition for final allowance, then it is requested that such amendments or corrections be carried out by Examiner's Amendment and the case passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing the case to allowance, he or she is invited to telephone the undersigned at 1-631-549 4700.

In view of the foregoing, favorable allowance is respectfully solicited.

Respectfully submitted,



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